



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/729,798

12/05/2003

Roy Hirst

MS305474.01/MSFTP1150US

2266

27195 7590 03/06/2009  
AMIN, TUROCY & CALVIN, LLP  
127 Public Square  
57th Floor, Key Tower  
CLEVELAND, OH 44114

EXAMINER

PEARSON, DAVID J

ART UNIT

PAPER NUMBER

2437

NOTIFICATION DATE

DELIVERY MODE

03/06/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket1@thepatentattorneys.com  
hholmes@thepatentattorneys.com  
lpasterchek@thepatentattorneys.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/729,798	<b>Applicant(s)</b> HIRST, ROY	
	<b>Examiner</b> DAVID J. PEARSON	<b>Art Unit</b> 2437	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 20-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

1. Claims 1, 6 and 16 have been amended. Claims 1-17 and 20-25 have been examined.

### ***Response to Arguments***

2. Applicant's arguments filed 11/18/2008 have been fully considered but they are not persuasive.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Objections***

4. Claims 1-5 are objected to because of the following informalities:

Claim 1 recites, "encrypting the combination." However, this phrase lacks antecedent basis because there is no "a combination" introduced. A unique identifier is associated with digitally-encoded material, but this does not constitute "a combination." Later, claim 1 recites "the encrypted digitally-encoded material." This phrase also lacks antecedent basis because the only "encrypted" object in the claim is an "encrypted" combination.

Claims 2-5 inherit the deficiency of the claim they depend on.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. Claims 1, 5-6, 8-16 and 20-21, are rejected under 35 U.S.C. 102(e) as being anticipated by Shen et al. (U.S. Patent Application Publication 2003/0149890; hereafter referred to as "Shen").

For claims 1, 11 and 16, Shen teaches a method and computer readable storage medium of storing digitally encoded material, the method comprising:

Associating a unique identifier with digitally encoded material (note paragraph [0064]) **and encrypting the combination** (note paragraph [0034]); and

Associating **a plurality of** (note paragraph [0059]) built-in functions (note paragraph [0085]) with the **encrypted** digitally encoded material such that the unique identifier and the built-in functions are coupled to the digitally encoded material (note paragraph [0034]); and

Rendering or transforming the digitally-encoded material based on the built-in functions (note paragraph [0094]), wherein the digitally-encoded material can be transformed and rendered only by the built-in functions (note paragraph [0017]).

For claims 6 and 21, Shen teaches a method and computer readable medium for tracking digitally encoded material, the method comprising:

Appending a unique identifier to the digitally encoded material (note paragraph [0064]);

encrypting a combination including the digitally encoded material and the unique identifier (note paragraph [0034]); and

appending built-in function source code (note paragraph [0085]) **to** the encrypted combination to form an executable entity (note paragraph [0037]) capable of being executed independent of a particular operating system (note paragraph [0015]), wherein the digitally-encoded material can be transformed and rendered only by the built-in functions (note paragraph [0017]); and

including at least an encryption (note paragraph [0015]) and decryption function with the built-in function source code (note paragraph [0032]).

For claims 5, 12 and 20, Shen teaches claims 1, 11 and 16 further including an encrypt function (note paragraph [0015]) and a decrypt function (note paragraph [0032]) the built-in functions that enables the digitally encoded material to be stored in RAM in an encrypted form (note paragraph [0094]).

For claims 8 and 13, the combination of Rabinovitch, Matsuyama and Friedman teaches claims 6 and 11 wherein the built-in functions include rendering functions (note paragraph [0094]) and transform functions (note paragraph [0032]).

For claims 9 and 14, the combination of Rabinovitch, Matsuyama and Friedman teaches claims 8 and 13 wherein the rendering functions include one or more of a close, find shape, full screen, go to guide, help, open (note paragraph [0094]), order pan, properties, reveal, rotate/flip, search, select, size, and position, spell check or zoom.

For claims 10 and 15, the combination of Rabinovitch, Matsuyama and Friedman teaches claims 8 and 13 wherein the transform function include one or more of copy, DRM agent (note paragraph [0032]), export, insert, log, new, paste, print, replace, or save as.

***Claim Rejections - 35 USC § 103***

6. Claims 2-3, 17 and 22-23, 17 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shen et al., and further in view of Matsuyama et al. (U.S. Patent 6,574,611, hereafter "Matsuyama").

For claims 2-3 and 17, Shen differs from the claimed invention in that they fail to teach:

Associating a history of the digitally encoded material with the digitally encoded material, wherein the history being located in a database.

Matsuyama teaches:

Associating a history of the digitally encoded material with the digitally encoded material (note column 23, lines 52-56), wherein the history being located in a database (note column 23, lines 11-21).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the IPMP tools of Shen and the usage history of Matsuyama. One of ordinary skill in the art at the time of the invention would have been motivated to

combine Shen and Matsuyama because it would provide a way for content providers to be compensated based on the usage of the content (note column 11, line 55 through column 12, line 8 of Matsuyama).

For claim 22, the combination of Shen and Matsuyama teaches claim 21 wherein the acts further comprise:

tracking the digitally encoded material by maintaining an auditable document history log (note column 23, lines 52-56 of Matsuyama).

For claim 23, the combination of Shen and Matsuyama teaches claim 22 wherein the auditable document history log is maintained in one of a file associated with the digitally-encoded material and a database independent of the digitally-encoded material (note column 23, lines 11-21 of Matsuyama).

7. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shen as applied to claims 1 and 6 above, and further in view of Rabinovitch (U.S. Patent Application Publication 2006/0101521).

For claims 4 and 7, Shen differs from the claimed invention in that they fail to teach:

wherein the built-in function includes one or more of Copy, Paste or Print.

Rabinovitch teaches:

wherein the built-in function includes one or more of Copy, Paste or Print (note paragraph [0047]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the IPMP tools of Shen and the copy and print control functions of Rabinovitch. One of ordinary skill in the art would have been motivated to combine Shen and Rabinovitch because it would increase the management of the digital content by allowing control over copying and printing of the content.

8. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Shen, Matsuyama and Rabinovitch as applied to claim 10 above, and further in view of Nelson (U.S. Patent 6,691,229).

For claim 24, the combination of Shen, Matsuyama and Rabinovitch differs from the claimed invention in that they fail to teach:

Including the copy function in the transform functions wherein upon executing the copy function a second unique identifier is generated and appended to a generated copy of the digitally encoded material such that the copy comprises the unique identifier and the second unique identifier.

Nelson teaches:

Including the copy function in the transform functions wherein upon executing the copy function a second unique identifier is generated and appended to a generated



copy of the digitally encoded material such that the copy comprises the unique identifier and the second unique identifier (note column 7, line 57 through column 8, line 11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the combination of Shen, Matsuyama and Rabinovitch with the enforcement data of Nelson. One of ordinary skill in the art at the time of the invention would have been motivated to combine Shen, Matsuyama, Rabinovitch and Nelson because it would allow unauthorized copies of content to be traced to the person who accepted the original (note column 4, lines 38-42 of Nelson).

For claim 25, the combination of Shen, Matsuyama, Rabinovitch and Nelson teaches claim 24, wherein executing the copy function updates document history of the digitally encoded material and the generated copy (note column 23, lines 52-56 of Matsuyama) and informs at least an author of the digitally encoded material of the generated copy (note column 9, lines 31-39; 57-61 of Matsuyama).

### ***Response to Arguments***

8. Applicant argues Shen fails to teach “appending built in functions to the content” (note Remarks, page 8).

Examiner disagrees. Applicant asserts Shen merely teaches “appending information regarding the playback tool to the data packet at the beginning of the content stream. The information is used by a terminal to retrieve the appropriate tool to

play the content. The functions to render the content would be compiled into the IPMP tool itself and not with the content" (note Remarks, page 8).

However, as noted above, Shen teaches in paragraph [0085] that the information Applicant alludes to can indicate the IPMP tool can be found "inside content stream." The "inside content stream" information indicates the tool is embedded in the content stream (note paragraph [0070]). Shen further teaches the IPMP Tool identifier that is appended to the content (note Fig. 2) has two parts: a location type and location details. According to Table 2, when the location type indicates "inside content stream" the location details state "this part should contain the IPMP tool itself" (note paragraph [0069]).

Therefore, Shen teaches "appending built in functions to the content" as required by the claims.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Vestergaard et al. (U.S. Patent 7,466,823) teaches content, decryption engine and viewer packaged into a single, executable file (note column 4, lines 36-38).

Glover (U.S. Patent 6,052,780) teaches digital information is stored as an executable program that includes a decryption program that decrypts the encrypted information (note Abstract).

Shen-Orr et al. (U.S. Patent Application Publication 2004/0111613) teaches packaging protected content and a descrambler (note paragraphs [0090]-[0092]).

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J. PEARSON whose telephone number is (571) 272-0711. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm; off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone

Art Unit: 2437

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. J. P./  
Examiner, Art Unit 2437

/Nasser G Moazzami/  
Supervisory Patent Examiner, Art Unit 2436